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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,894

07/11/2003

Phillip J. Bouic

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06/27/2006

3M INNOVATIVE PROPERTIES COMPANY

PO BOX 33427

ST. PAUL, MN 55133-3427

EXAMINER

VO, HAI

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,894	Applicant(s) BOUIC ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 27-43 and 45-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-26, 44 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The claim objections are maintained.
2. The double patenting rejections are maintained.
3. The art rejections over Bambara et al (US 5,350,544), WO 99/46056, Bouic (US 6,797,361) and EP 795356 are maintained.
4. The art rejections over WO 99/52646 and Francis et al (US 4,996,092) are withdrawn in view of the present amendment.

Claim Objections

5. Claims 23-26, and 44 are objected because the claims depend from non-elected claim 1. It is suggested that claim 23 is rewritten in independent form including "a predetermined surface pattern" as described in claim 1.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 23-26, 44 and 65 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of

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U.S. Patent No. 6,797,361 substantially as set forth in the 01/12/2006 Office Action.

8. Claims 23-26, 44 and 65 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-48 of copending Application No. 10/617,893 substantially as set forth in the 01/12/2006 Office Action.

The obviousness-type double patenting will not be withdrawn until the submission of the terminal disclaimer.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 23, 24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Bambara et al (US 5,350,544) substantially as set forth in the 01/12/2006 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does Bambara disclose or teach a polymeric article including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially

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compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern". The examiner respectfully disagrees. Any foam article having a surface pattern with a variation in thickness will read on the claimed subject matter. Bambara teaches a rigid, closed cell polyethylene foam article having a surface embossed with a three-dimensional, foam-tread-wear surface which gives the illusion of a variation in thickness. Accordingly, the art rejections are sustained.

11. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/46056 substantially as set forth in the 01/12/2006 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that nowhere does WO '056 disclose or teach a polymeric article including "a predetermined surface pattern in at least a portion of the sheet, the surface pattern including at least a first area that is partially compressed to define at least a part of the surface pattern and at least a second area that is compressed either more or less than the first area to define the predetermined surface pattern". The examiner respectfully disagrees. WO'056 teaches a foam strip for masking a gap between two parts of the vehicle having a surface pattern formed by applying pressure to the surface of the foam strip as shown in figure 2A. The foam strip includes an elongate strip 8 and a removable edge portion 10 which have different dimensions. Accordingly, the art rejections are sustained.

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12. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Bouic (US 6,797,361) substantially as set forth in the 01/12/2006 Office Action. Similarly, the art rejections over Bouic have been maintained. Bouic teaches a foam strip for masking a gap between two parts of the vehicle including an array of longitudinally extending parallel foam cords 5 joined by a cold weld seams 4. The foam cord and the seam read on Applicants' first and second portions of the surface pattern.
13. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as being anticipated by Barrows et al (US 5,547,725). Barrows teaches a foam article suitable as a masking tape comprising a plurality of circular strips joined together by a joinder line as shown in figure 5. The circular strip and joinder read on Applicants' first and second portions of the surface pattern. The adhesive is applied to the top and bottom of the foam strips. The foam strips are formed of polyolefin and have a density of 1 to 6 pcf (column 1, lines 57-61). Accordingly, Barrows anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 23-26, 44 and 65 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 795 356 substantially as set forth in the 01/12/2006 Office Action. EP'356 teaches a masking strip for temporarily masking automotive body gaps in paint-spraying operations. The masking strip is made from an open celled polyurethane foam having a density from 20 to 30 kg/m³ [0002] and [0020]. The masking strip has two portions 12 and 11 with different thickness as shown in figure 1. The art rejections over EP '356 are sustained.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

HV

Hai Vo

**HAIVO
PRIMARY EXAMINER**